

REMARKS

Upon entry of the present amendments, claims 163-168, 170-171, 173-180, 182-188, 190-198, and 200-206 constitute the pending claims in the present application. Claims 1-162, 169, 172, 181, 189, and 199 were previously cancelled. Claims 163-168, 170-171, 173-180, 182-188, 190-198, and 200-202 stand rejected. Claims 203-206 are new.

Telephonic Interview and Amendments

Applicants appreciate the time and attention of Examiner Lacyk during the telephonic interview of August 13, 2007. During the interview Applicants and the Office discussed the outstanding anticipation and obviousness rejections over U.S. Patent No. 5,336,231 to Adair (“Adair”) and U.S. Patent No. 4,935,027 to Yoon (“Yoon”). In particular, Applicants asserted that contrary to the Office’s contentions in the outstanding Office Action, neither Adair nor Yoon teach a sling as recited in independent claims 163, 175, 185, and 193. The Office submitted that the sutures disclosed in these references could function as slings. Applicants and the Office then agreed that further clarification on the structural features of the presently recited slings could distinguish these from the sutures disclosed in Adair and Yoon.

Accordingly, Applicants have amended claims 163, 175, 185, and 193 to more particularly define the presently claimed invention. In particular, these claims have been amended to recite that the sling is a urethral support sling having a substantially flat shape. Support for this amendment can be found in the specification as originally filed, for example, at least in the paragraph spanning pages 34-35, which describes a flat sling. Support for this amendment can also be found in Figures 16-17 and 18-19, which depict slings 216 and 316, respectively, with their substantially flat shapes in both top and cross-sectional views.

Applicants have also amended claim 202 to correct antecedence.

New Claims

Applicants have added claims 203-206, which recite that “the pouch covers an end of the sling.” Support for these amendments can be found in the application as originally filed, for example, in Figs. 15-21 and 51, which depict the pouch covering an end of the sling.

Applicants assert the present amendments to claims 163, 175, 185, 193, and 202 as well as new claims 203-206 do not add new matter. Applicants reserve the right to pursue the subject matter of the claims as unamended in one or more continuation and/or divisional applications.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Office will be addressed below in the order they appear in the Office Action.

1. Information Disclosure Statement

Applicants note with appreciation that the objections set forth in the Office Action dated November 14, 2006 concerning Applicants' previously submitted Information Disclosure Statement have been withdrawn.

2. Claim Rejections – 35 U.S.C. 102(b) – Claims 175-180 and 185-188

Claims 175-180 and 185-188 stand rejected under 35 U.S.C. 102(b) as being anticipated by Adair. Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

Applicants previously submitted that Adair does not teach "a sling assembly comprising a supportive sling" as recited in claims 175 and 185 (see page 7 of Applicants Reply dated February 13, 2007). Although the Office previously contended that element 82 in Fig. 28-37 of Adair is a sling (see page 3, paragraph 5f. of the November 14, 2006 Office Action), Applicants pointed out and now restate that element 82 is a portion of suture 18 (see column 8, lines 6-8); it is not a urethral support sling for treating urinary incontinence.

With the present amendments, the recited sling has a substantially flat shape and is further distinguished from the Adair suture. Notably, the Adair suture is simply not taught or suggested to have a substantially flat shape, and one of skill in the art would recognize that a suture, particularly as taught by Adair, is a thread or wire and does not have a substantially flat shape. Consequently, the suture portion 82 of Adair is not equivalent to or interchangeable with the urethral support sling of claims 175 and 185, and Adair does not teach or suggest all the features of claims 175 and 185.

Since a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (see MPEP 2131 quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)), Adair cannot be said to anticipate claims 175 and 185 or claims dependent thereon. As such, Applicants request reconsideration and withdrawal of the anticipation rejection over Adair.

3. Claim Rejections – 35 U.S.C. 102(b) – Claims 193-198

Claims 193-198 remain rejected under 35 U.S.C. 102(b) as being anticipated by Yoon. Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

Applicants assert that the issues in the present rejection over Yoon are analogous to those in the above rejection over Adair. Namely, the Office contends that Yoon teaches a sling and refers to column 2, lines 9-11 of Yoon, which states “The suture material can be any of a variety of rigid, semi-rigid, bioabsorbable or non-bioabsorbable *suture material*.” (emphasis added). Applicants assert that the skilled artisan would take this passage of Yoon at face value, i.e., that Yoon is describing a suture and not a urethral support sling and certainly not a urethral support sling having a substantially flat shape. As noted above, one of skill in the art would recognize that a suture as taught by the cited art is a thread or wire but not a urethral support sling having a substantially flat shape. Consequently, the suture material of Yoon is not equivalent to or interchangeable with the urethral support sling of claim 193, and Yoon does not teach or suggest all the features of claim 193. Accordingly, Yoon cannot be said to anticipate claim 193 or claims dependent thereon, *Verdegaal, supra*, and Applicants request reconsideration and withdrawal of the anticipation rejection over Yoon.

4. Claim Rejections – 35 U.S.C. 103(a) – Claims 182-184 and 190-192

Claims 182-184 and 190-192 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Adair in view of U.S. Patent No. 3,580,256 to Wilkinson et al. (“Wilkinson”). Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

As noted above, Adair fails to teach all the features of claims 175 and 185, for example, the urethral support sling having a substantially flat shape. Wilkinson also does not teach this feature but instead teaches a pre-tied suture for suturing (see Abstract). As noted above, a suture is quite different from the sling recited in claims 175 and 185.

Pursuant to MPEP 2142, “[t]o establish a prima facie case of obviousness...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Since Adair and Wilkinson, either alone or in combination, fail to teach or suggest all the features of claims 175 and 185, these claims and those dependent thereon cannot be found obvious over these references. As such, Applicants request reconsideration and withdrawal of the obviousness rejection of claims 182-184 and 190-192 which are dependent on claims 175 and 185, respectively.

5. Claim Rejections – 35 U.S.C. 103(a) – Claims 163-168, 170-171, 173-174, and 200-202

Claims 163-168, 170, 171, 173-174, and 200-202 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon in view of U.S. Patent No. 5,383,904 to Totakura et al. (“Totakura”). Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

As noted for the above anticipation rejection over Yoon, this reference fails to teach a urethral support sling having substantially flat shape, which is a feature of claims 163 and 193. Totakura also does not teach this feature. Rather Totakura teaches a stiffening agent 22 that is “disposed on at least a portion of the suture [12]” (column 2, lines 6-7). Hence, Totakura provides a suture and therefore suffers from the same deficiencies as Adair and Yoon above.

Applicants note that the stiffening agent 22 of Totakura is a chemical that is “preferably liquid or liquid soluble for ease of application” (column 3, lines 26-27) and that Totakura describes at length the solubility properties of the stiffening agent to facilitate its application (column 3, lines 43-50). As such, like the suture 12, the stiffening agent is also not a urethral support sling having a substantially flat shape. Applicants assert that the depiction of the stiffening agent 22 in the lone

rudimentary figure of Totakura is an exaggeration meant only to convey a concept difficult to illustrate, i.e., that the chemical stiffening agent has been applied to certain portions of the suture 12.

Since Yoon and Totakura, either alone or in combination, fail to teach or suggest all the features of claims 163 and 193, these claims and those dependent thereon cannot be found obvious over these references. As such, Applicants request reconsideration and withdrawal of the obviousness rejection of claims 163-168, 170, 171, 173-174, and 200-202, which are dependent on claim 193.

6. Withdrawal of Rejections

Applicants note with appreciation the withdrawal of the prior rejection of claims 163-171, 173-174, and 200-202 under 35 U.S.C. 103(a) over Yoon in view of Wilkinson.


CONCLUSION

In view of the above arguments and amendments, Applicants believe the pending application is in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000.

Should an extension of time in addition to that already requested herewith be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to Deposit Account No. 18-1945, under Order No. MIY-P03-006 from which the undersigned is authorized to draw.

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Respectfully submitted,

By 

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